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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/567,294

04/10/2006

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576P085

8481

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07/25/2008

EXAMINER

SELLERS, ROBERT E

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/567,294	Applicant(s) MIZUTANI ET AL.	
	Examiner Robert Sellers	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-9 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>27 April 2006</u> . | 6) <input type="checkbox"/> Other: ____. |

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1 and 5-7, drawn to an adhesive composition comprising a bisphenol epoxy(meth)acrylate, a cyclic ether structure-containing di(meth)acrylate and a photopolymerization initiator.

Group II, claim 2, drawn to an adhesive composition comprising a bisphenol epoxy(meth)acrylate, a cyclic ether structure-containing di(meth)acrylate, a photopolymerization initiator and a (meth)acrylate phosphate compound.

Group III, claim 3, drawn to an adhesive composition comprising a bisphenol epoxy(meth)acrylate, a cyclic ether structure-containing di(meth)acrylate, a photopolymerization initiator and a urethane (meth)acrylate.

Group IV, claim 4, drawn to an adhesive composition comprising a bisphenol epoxy(meth)acrylate, a cyclic ether structure-containing di(meth)acrylate, a photopolymerization initiator, a (meth)acrylate phosphate compound and a urethane (meth)acrylate.

Group V, claims 8 and 9, drawn to a bonded optical disk.

2. The inventions listed as Groups I to V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature. The special technical feature is the combination of bisphenol epoxy(meth)acrylate and cyclic ether structure-containing di(meth)acrylate.
3. Tokuda et al. Patent No. 6,284,185 (equivalent to Japanese Patent No. 9-31416 cited in the International Search Report and Information Disclosure Statement filed February 6, 2006 and April 27, 2006, respectively) in columns 7 and 8, Table 1, Example 9 shows a blend of EPA-1 bisphenol epoxy acrylate and R-604 corresponding to the claimed cyclic ether-containing di(meth)acrylate according to page 11, lines 5-7 of the instant specification.
4. Japanese Patent No. 10-7751 on page 5, Table 1, Example 2 shows a mixture of Kayarad R-114 which is a bisphenol A epoxy diacrylate according to CAS registry no. 53814-24-7 and Kayarad R-604.

Accordingly, the special technical feature does not make a contribution over the prior art, thereby validating a holding of lack of unity.

5. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

(B) The cyclic ether structure-containing di(meth)acrylate such as the hydroxypivalic aldehyde-modified trimethylolpropane diacrylate R-604 of claim 7 employed in Example 1 on page 26 of the specification.

(C) The photopolymerization initiators such as the 2,2-dimethoxy-1,2-diphenylethane-1-one Irgacure 651 of Example 1.

Contingent upon the election of Group II or IV, items (B) and (C) hereinabove and:

(D) The (meth)acrylate phosphate compounds such as the ethylene oxide modified dimethacrylate phosphate PM-2 of Example 1.

Contingent upon the election of Group III or IV, items (B) and (C) hereinabove and:

(E) The urethane (meth)acrylates such as the polyether-based urethane acrylate UA-732 of Example 1.

(Group IV requires the election of both components (D) and (E)).

Applicant is required, in reply to this action, to elect a single species ***within each of items (B), (C), and (D) and/or (E) if appropriate***, to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Claims 1-9 are generic.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for reasons espoused with respect to the holding of lack of unity hereinabove.

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6. The term "type" used to characterize the bisphenol epoxy(meth)acrylate in claims 1 and 4 embraces modifications and/or derivatives not contemplated and should be stricken for a more concise definition thereof.

The prior art made of record and not relied upon is considered pertinent to the disclosure.

7. Japanese Patent No. 2002-114949 shows a composition comprising a bisphenol A epoxy (meth)acrylate, a phosphate (meth)acrylate, a urethane (meth)acrylate and a photoinitiator.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Robert Sellers/
Primary Examiner
Division 1796

rs
7/21/2008